



Atty. Dkt. No. 034536-1211

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Joseph SCHLESSINGER et al.  
Title: NOVEL RECEPTOR-TYPE  
PHOSPHOTYROSINE  
PHOSPHATASE-ALPHA  
Appl. No.: 10/777,145  
Filing Date: February 13, 2004  
Examiner: Rebecca E. Prouty  
Art Unit: 1652

<b>CERTIFICATE OF EXPRESS MAILING</b>	
I hereby certify that this correspondence is being deposited with the United States Postal Service's "Express Mail Post Office To Addressee" service under 37 C.F.R. § 1.10 on the date indicated below and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
EL 962424565 US (Express Mail Label Number)	March 21, 2006 (Date of Deposit)
Cassandra Williams (Printed Name)	
<i>Cassandra Williams</i> (Signature)	

**TERMINAL DISCLAIMER**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Your Petitioner, New York University, having its principal place of business at 550 First Avenue, New York, New York 10016, represents that it is the owner of the entire right, title, and interest in and to U.S. Patent Application Serial No. 10/777,145, filed February 13, 2004, which is a continuation of U.S. Patent Application No. 10/671,589, filed September 29, 2003, by virtue of an Assignment filed and recorded on June 22, 1993, on Reel/Frame 006815/0398, in the United States Patent and Trademark Office, a copy of which is attached hereto as APPENDIX A. Further, your Petitioner represents that it is the owner of U.S. Patent Application No. 10/777,186, filed February 13, 2004, which is a continuation of U.S. Patent Application Serial No. 08/015,985, filed February 10, 1993, by virtue of an Assignment filed and recorded on June 23, 1993, on Reel/Frame 006815/0398, in the United States Patent and Trademark Office, a copy of which is attached hereto as APPENDIX A.

Your Petitioner, New York University, hereby disclaims the terminal part of the term of any patent granted on U.S. Patent Application 10/777,145 which would extend beyond the full statutory term, as shortened by any terminal disclaimer, of any patent granted

on U.S. Patent Application 10/777,186, and hereby agrees that any patent so granted on U.S. Patent Application 10/777,145 shall be enforceable only for and during such period that the legal title to any patent granted on U.S. Patent Application 10/777,186 shall be the same as the legal title to any patent granted on U.S. Patent Application 10/777,145, this agreement to run with any patent granted on U.S. Patent Application 10/777,145 and to be binding upon the grantee, its successors or assigns.

In making the above disclaimer, Petitioner does not disclaim any terminal part of any patent granted on U.S. Patent Application 10/777,145, prior to the full statutory term of any patent granted on U.S. Patent Application 10/777,186 as defined in 35 U.S.C. §§154-156 and 173, in the event that any patent granted on U.S. Patent Application 10/777,186 expires for failure to pay a maintenance fee, is held unenforceable or is found invalid in a final judgment by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR §1.321(a), has all claims canceled by a reexamination certificate or as a result of an interference proceeding, or is otherwise not deemed to provide the rights conveyed by 35 USC §154, prior to the full statutory term of any patent granted on U.S. Patent Application 10/777,186 as defined in 35 USC §§154-156 and 173, except for the separation of legal title stated above. Further, Petitioner does not disclaim any terminal part of a patent granted on U.S. Patent Application 10/777,145 that would extend beyond the present termination of any patent granted on U.S. Patent Application 10/777,186, in the event that such present term is extended by virtue of compliance with the conditions for term extension of any present or future patent term extension provisions of the patent law, including but not limited to 35 U.S.C. §§155, 155A or 156, and without waiving Petitioner's right to extend the term of a patent granted on U.S. Patent Application 10/777,145 to the extent provided by law.

The undersigned, being the Attorney of Record for U.S. Patent Application 10/777,145, and duly authorized to act on behalf of Petitioner, certifies that he has reviewed the Assignment attached as APPENDIX A, and to the best of his knowledge and belief, legal title to U.S. Patent Application 10/777,145 and any patent granted on U.S. Patent Application 10/777,186 rests with Petitioners, New York University. The undersigned declares that all statements made herein of his own knowledge are true and that all statements made on

information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-identified application or any patent issuing therefrom.

Respectfully submitted,

Date March 21, 2006

By Vid S. Mohan Ram

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Registration No. 35,087  
Attorney(s) for Applicants

## **APPENDIX A**



## ASSIGNMENT

WHEREAS, WE, Joseph SCHLESSINGER and Jan M. SAP, ASSIGNORS, citizens of Israel and Belgium, residing at 37 Washington Square West, New York and 545 First Avenue, Apt. 7B, New York, are the inventors of the invention in NOVEL RECEPTOR-TYPE PHOSPHOTYROSINE PHOSPHATASE-ALPHA for which we have executed an application for a Patent of the United States

which is identified by Pennie & Edmonds docket no. 7683-020  
 which was filed on February 10, 1993, Serial No. 08/015,985

and WHEREAS, NEW YORK UNIVERSITY, ASSIGNEE is desirous of obtaining the entire right, title and interest in, to and under the said invention and the said application:

NOW, THEREFORE, in consideration of the sum of One Dollar (\$1.00) to us in hand paid, and other good and valuable consideration, the receipt of which is hereby acknowledged, we, the said ASSIGNORS, have sold, assigned, transferred and set over, and by these presents do hereby sell, assign, transfer and set over, unto the said ASSIGNEE, its successors, legal representatives and assigns, the entire right, title and interest in, to and under the said invention, and the said United States application and all divisions, renewals and continuations thereof, and all Patents of the United States which may be granted thereon and all reissues and extensions thereof; and all applications for industrial property protection, including, without limitation, all applications for patents, utility models, and designs which may hereafter be filed for said invention in any country or countries foreign to the United States, together with the right to file such applications and the right to claim for the same the priority rights derived from said United States application under the Patent Laws of the United States, the International Convention for the Protection of Industrial Property, or any other international agreement or the domestic laws of the country in which any such application is filed, as may be applicable; and all forms of industrial property protection, including, without limitation, patents, utility models, inventors' certificates and designs which may be granted for said invention in any country or countries foreign to the United States and all extensions, renewals and reissues thereof;

AND WE HEREBY authorize and request the Commissioner of Patents and Trademarks of the United States, and any Official of any country or countries foreign to the United States, whose duty it is to issue patents or other evidence or forms of industrial property protection on applications as aforesaid, to issue the same to the said ASSIGNEE, its successors, legal representatives and assigns, in accordance with the terms of this instrument.

AND WE HEREBY covenant and agree that we have full right to convey the entire interest herein assigned, and that we have not executed, and will not execute, any agreement in conflict herewith.

AND WE HEREBY further covenant and agree that we will communicate to the said ASSIGNEE, its successors, legal representatives and assigns, any facts known to us respecting said invention, and testify in any legal proceeding, sign all lawful papers, execute all divisional, continuing, reissue and foreign applications, make all rightful oaths, and generally do everything possible to aid the said ASSIGNEE, its successors, legal representatives and assigns, to obtain and enforce proper protection for said invention in all countries.

IN TESTIMONY WHEREOF, We hereunto set our hands and seals the day and year set opposite our respective signatures.

Date 02/10/93, 1993 J. Sch L.S.

Date 06/11/93, 1993 J. Sch ~~RECORDED~~ L.S.

State of New York) SS.: J. Sch JUN 22 93

County of New York)

On this 10<sup>th</sup> day of June, 1993, before me, a Notary Public in and for the State and County aforesaid, personally appeared Joseph Schlessinger, to me known and known to me to be the person of that name, who signed and sealed the foregoing instrument, and he acknowledged the same to be his free act and deed.

State of New York) SS.: Charmaine-Ann Ottley Notary Public.

County of New York)

On this 11 day of June, 1993, before me, a Notary Public in and for the State and County aforesaid, personally appeared Jan Sap, to me known and known to me to be the person of that name, who signed and sealed the foregoing instrument, and he acknowledged the same to be his free act and deed.

CHARMAINE-ANN OTTLEY Notary Public, State of New York

No. 41-4959923

Qualified in Queens County

Commission Expires December 18, 1993

Notary Public.